

Philippine Madrid Regulations Act of 2024

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On 1 July 2024, the Intellectual Property Office of the Philippines (IPOP HL) promulgated Memorandum Circular No. 2024-024 or the Philippine Madrid Regulations Act of 2024, which amends the previous rules implementing the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol).

The Madrid Protocol provides for the international registration of marks, which allows for the protection of marks in each of the designated Contracting Parties.

The amended rules became effective on 25 July 2024.



Coverage and Applicability

The Circular adopts the relevant provisions of the Regulations under the Madrid Protocol. It shall apply to all international applications filed under the Madrid Protocol where IPOP HL is the Office of Origin and international registrations (IR) where the Philippines is a Designated Contract Party (DCP).

Applicability of TM Regulations (Rules and Regulations on Trademarks, Service Marks, etc.)

Relevant TM Regulations, including the requirement of a local agent for any submission before the IPOP HL, and the adoption and use of its online systems, continue to apply. International Applications shall be filed through the Madrid online filing system, and subsequent requests through the IPOP HL's online submission system.

Recording in International Register

Any recording made in the International Register in respect of an IR shall, to the extent that it applies to the Philippines as a DCP, have the same effect as if it had been recorded by the IPOP HL.

In the case of license contracts recorded with the International Bureau, the holder must show to the IPOP HL that it complies with the Philippine laws and rules on voluntary licensing. Upon payment of fees, the license contract shall be reviewed and a certificate of compliance shall be issued. Otherwise, the contract shall not be enforceable.

Collective Marks and Certification Marks

In the case of a collective mark or certification mark, a copy of the agreement governing its use shall be submitted to the IPOP HL within two months from the date of international registration with the International Bureau.

Replacement

The holder of an IR may request the IPOP HL for a replacement of a mark registered in the Philippines with the IR. Where the IPOP HL takes note of such IR, it shall notify the International Bureau and

maintain in its register the replaced national registration as long as the IR remains validly registered.

Transformation

Where an IR designating the Philippines is cancelled at the request of the Office of Origin, the holder may request to transform the IR into a national application within 3 months from the date of cancellation.

Declaration of Actual Use (DAU)

All holders of IRs that designate the Philippines shall file a Declaration of Actual Use (DAU) with the IPOPHL, or show valid reasons for non-use, within three (3) years from the date of international registration or subsequent designation.

Within 1 year from the fifth anniversary of the statement of grant of protection or renewal of registration, all holders of IRs shall file a DAU or show valid reasons for non-use.

All holders of IRs shall file a DAU within 1 year from the date of renewal of registration.

Failure to file the DAU as required shall be cause for the removal of the mark from the IPOPHL register, unless a Declaration of Non-Use (DNU) has been submitted.

DAU related to national registrations subject of Replacement/Transformation

Where the IPOPHL has taken note of an IR in case of replacement, the holder of the IR shall file a DAU as prescribed above.

Where the application or registration results from transformation, and a DAU was filed before the IR was transformed, such DAU shall be considered for the national application. Where a DAU has not been filed before the IR was transformed, the DAU must be filed following the dates prescribed above.

Renewal

IRs shall be renewed with the International Bureau in the manner prescribed by the Madrid Protocol and Regulations.

What should companies do?

Concerned companies are advised to take note of the updates procedures on international registration, especially with regard to the timely and complete submission of Declaration of Actual Use required to maintain trademark registrations.

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Camille received her Juris Doctor degree from the University of the Philippines in 2018. She graduated in the top 10 of her class and was awarded the Dean’s Medal for Academic Excellence. She is also a member of the Order of the Purple Feather (UP Law Honors Society).

In 2022, Camille received a Japanese Government (MEXT) Scholarship for the Young Leaders Program (YLP) in Law. She earned her LL.M degree (Master of Laws) from Kyushu University in 2023.

She joined One Asia Lawyers in 2023 and advises on Philippine laws relating to business establishment and investment, labor and employment, data privacy, and corporate law.

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